



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2010 TMOB 115
Date of Decision: 2010-07-14

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Farleyco Marketing, Inc. against
registration No. TMA442,464 for the trade-mark
MESMERIZE in the name of Avon Products, Inc.**

[1] On May 13, 2008, at the request of Farleyco Marketing, Inc. (the Requesting Party), the Registrar forwarded a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) to Avon Products, Inc. (the Registrant), the registered owner of the above-referenced trade-mark (the Mark).

[2] The Mark is registered for use in association with “woman's fragrance, namely, roll-on, talc, perfumed cream, lotion, body spray, bath and shower gel”.

[3] Section 45 of the Act requires the registered owner to show whether the trade-mark has been used in Canada in association with each of the wares or services specified in the registration at any time within the three year period immediately preceding the date of the notice and, if not, the date when it was last in use and the reason for the absence of such use since that date. In this case, the relevant period for showing use is any time between May 13, 2005 and May 13, 2008 (the relevant period).

[4] “Use” in association with wares is set out in s. 4(1) and 4(3) of the Act:

4. (1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the

association is then given to the person to whom the property or possession is transferred.

[...]

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

In this case, s. 4(1) of the Act applies.

[5] In response to the Registrar's notice, the Registrant furnished the affidavits of Anthony M. Santini, Vice President & Associate General Counsel of the Registrant sworn August 6, 2008, and Colleen Leithman, Senior Legal Counsel of Avon Canada Inc. (Avon Canada) sworn August 6, 2008 together with Exhibits A to D. Only the Registrant filed written submissions; an oral hearing was not requested.

[6] It is well established that the purpose and scope of s. 45 of the Act is to provide a simple, summary and expeditious procedure for removing deadwood from the register and as such, the threshold test is quite low. As stated by Mr. Justice Russell in *Uvex Toko Canada Ltd. v. Performance Apparel Corp.* (2004), 31 C.P.R. (4th) 270:

68. [...] We know that the purpose of s. 45 proceedings is to clean up the "dead wood" on the register. We know that the mere assertion by the owner that the trade mark is in use is not sufficient and that the owner must "show" how, when and where it is being used. We need sufficient evidence to be able to form an opinion under s. 45 and apply that provision. At the same time, we need to maintain a sense of proportion and avoid evidentiary overkill. We also know that the type of evidence required will vary somewhat from case to case, depending upon a range of factors such as the trade mark owners business and merchandising practices.

[7] Turning to the evidence of use of the Mark by the Registrant, Ms. Leithman states in her affidavit that Avon Canada is the licensed user in Canada of the Mark. This statement of Ms. Leithman is corroborated by Mr. Santini's affidavit that only serves to address the issue of control over the character and quality of the wares sold by Avon Canada under the Mark. More particularly, Mr. Santini states that "[t]he character and quality of the wares sold by Avon Canada under the [Mark] is under the control of [the Registrant]". This sworn statement of Mr. Santini is sufficient to ensure that the Registrant can rely on s. 50(1) of the Act, so that use

of the Mark by Avon Canada accrues to the Registrant [*Nissan v. MAAX Canada Inc.* (2007), 65 C.P.R. (4th) 99 (T.M.O.B.)].

[8] Ms. Leithman states that the Registrant, through its licensee Avon Canada, has used the Mark “as covered by Registration No. TMA442,464, including in particular as of the three years prior to the date of the [s.] 45 [n]otice”. More particularly, Ms. Leitman explains that “[p]roducts bearing the [Mark] are offered for sale and sold by over 65,000 Avon Sales Representatives in each and every province and territory in Canada who present Avon catalogues and samples to potential consumers. Avon Sales Representatives distribute the Avon catalogues directly to existing and potential customers across Canada”. Ms. Leitman further explains that “[c]onsumers in Canada who wish to order products offered for sale in Avon catalogues place orders with Avon sales representatives, who then place such orders with Avon Canada. Upon receipt of the products ordered from Avon Canada, Avon Sales Representatives then deliver the products to the ultimate consumers, who then pay the Avon Sales Representatives for the purchase.” Consumers can also place an order to Avon Canada directly through a toll free telephone number, which is provided on Avon catalogues and on Avon Canada’s enabled website at “www.avon.ca”.

[9] Ms. Leithman provides the number of Avon catalogues distributed throughout every province and territory in Canada during the relevant period, which vary between 15,000,000 and 32,000,000 catalogues per year. She further attaches to her affidavit as Exhibit C, copies of “the front cover, back cover, and sample pages of representative Avon catalogues from the [relevant] period [...], offering MESMERIZE products for sale” and as Exhibit D, copies of “the front cover, back cover, and sample pages of a representative Avon catalogue dated after May 13, 2008, offering MESMERIZE products for sale showing the intention to continue to use this trade-mark”.

[10] Ms. Leithman also provides that the “annual sales of products bearing the [Mark] throughout every province and territory in Canada” for the years 2007 and 2008 exceed \$1,800 and \$120,000 respectively. She further attaches as Exhibit B, “[r]epresentative sample of invoices in Canada for the [relevant period] for MESMERIZE products”.

[11] While Ms. Leithman sets out the Registrant’s normal course of trade and provides statements of facts that the Mark has been used in Canada during the relevant period together

with supporting exhibits, she does not expressly refer to *each* of the wares as they are defined in the registration. Ms. Leithman always broadly refers to the “MESMERIZE products”. This brings me to discuss in further detail the nature of the wares associated with the Mark in light of the evidence submitted in this proceeding.

[12] The invoices attached as Exhibit B all evidence the sale of MESMERIZE eau de cologne spray bottles bearing product number 081-990, which number corresponds to the one displayed for this product in Avon catalogues.

[13] The copies of catalogues filed as Exhibit C clearly show how the Mark is displayed on the cap of woman’ eau de cologne spray bottle offered for sale in the women’s fragrance section of these catalogues. The Mark is also referred to in one of these catalogues as “Not shown in this brochure...but always available” in association with roll-on deodorant and soap on a rope. The Mark is also displayed on men’s hair and body wash and aftershave conditioner offered for sale in the catalogues. However, soap on a rope and these latter men’s products are not listed in the instant registration.

[14] The copies of catalogue filed as Exhibit D again clearly show the Mark displayed on the cap of woman’s eau de cologne spray bottle. More particularly, the MESMERIZE eau de cologne spray bottle is offered for sale as a trio in combination with MESMERIZE “shimmering body powder” and “perfumed skin softener”. The Mark is displayed on the body powder. It is also clearly shown to be associated with the perfumed skin softener offered in the catalogue. While this latter catalogue is dated July 21, 2008, that is approximately two months after the relevant period, I note that Ms. Leithman states in paragraphs 17 and 18 of her affidavit that it is provided as an example of a representative Avon catalogue showing the intention of the Registrant “to continue to use [the Mark] in Canada, as it has in the past, including in particular [during the relevant period]”.

[15] Having regard to the evidence as a whole, and bearing in mind the purpose and intent of s. 45, I am satisfied that there was use of the Mark within the meaning of s. 45 and 4(1) of the Act in association with “woman's fragrance, namely, roll-on, talc, perfumed cream, lotion, body spray”. In this regard, I am prepared to conclude that use of the Mark in association with “perfumed skin softener” amounts to use of the Mark in association with “perfumed cream,

lotion”. However, I am not prepared to conclude that use of the Mark in association with “woman’s fragrance, namely, . . . bath and shower gel” has been shown. As per my review of the evidence above, Ms. Leithman has made no specific statement clearly attesting to use in association with *each* of the wares nor is there a sufficient factual basis on which such use can be inferred. The requirement to demonstrate use with each of the wares covered by the instant registration would not have placed an unreasonable burden on the Registrant [see *John Labatt v. Rainier Brewing Co. et al*, (1984) 80 C.P.R. (2d) 228 (F.C.A) for the general principle that where the registered owner chooses to register a list of wares, the implication is that one ware is different from the other, and therefore that use must be shown on each ware; and *Aerosol Fillers Inc. v. Plough (Canada) Ltd.* (1980), 45 C.P.R. (2d) 194 and *Wrangler Apparel Corp. v. Pacific Rim Sportswear Co.* (2000), 10 C.P.R. (4th) 568 (T.M.O.B.) for the general principle that any ambiguity in the evidence in the record must be resolved against the interests of the registered owner]. Since no evidence of use has been provided for these two wares, nor have special circumstances been advanced to excuse non-use, they ought to be deleted from the registration.

[16] Consequently, in view of the above, I am satisfied that use of the Mark within the meaning of s. 45 and 4(1) of the Act has been shown in association with “woman’s fragrance, namely, roll-on, talc, perfumed cream, lotion, body spray” only. Pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will therefore be amended to delete “bath and shower gel” from the statement of wares for failure to show use pursuant to s. 45 of the Act.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office